

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the foregoing amendments and the following remarks.

Claims 113-116 and 118-151 are pending in the present application, including independent claims 113, 133, and 146. Independent claim 113 has been amended in this paper to include the limitations from dependent claim 117, while dependent claim 117 is being cancelled in this paper.

Independent claim 113, for instance, is directed to a carpet comprising a primary backing and a piling yarn inserted therethrough. The primary backing comprises a composite fibrous material, which consists of a woven fabric having warp and fill yarns needlepunched to a bonded nonwoven fabric. As amended herein, the woven fabric recited in claim 113 has a weight of between about 2 ounces per square yard to about 8 ounces per square yard. The primary backing has a dimensional stability of about 3 pounds to about 20 pounds, wherein the dimensional stability is determined by grabbing and pulling the backing at a 45 degree angle in relation to the warp and fill yarns of the backing such that the backing incurs approximately a 5% elongation.

In the Office Action, former dependent claim 117, as well as independent claims 133 and 146, were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,380,574 to Katoh, et al. in view of U.S. Patent No. 4,053,668 to Kimmel, et al. Katoh, et al. is directed to a mat or a rug that does not slide when put on a carpet, such as the carpet on the floor of an automobile. (Col. 1, lines 6-12). The mat has a laminate structure composed of: (A) a reverse side mat layer including (a) a laminated mat composed of (a¹) base fabric and (a²) nonwoven fabric made of a thermoplastic resin fibrous binder, the base fabric (a¹) and nonwoven fabric (a²) being united by needling, (b) cut piles made of a thermoplastic resin implanted from one side of the laminated mat (a), and (c) a resin adhesive layer formed by coating a liquid resin adhesive on the nonwoven fabric (a²) on the side opposite to the cut piles (b) and drying; (B) a thermoplastic resin adhesive layer; and (C) a surface mat layer, wherein the surface mat layer (C) is adhered via the thermoplastic resin adhesive layer (B) to the reverse side mat layer (A) on the side of the reverse side mat layer (A) on which the

liquid resin adhesive has been coated. The cut piles (b) are implanted under very specific conditions, including implanting density, implanting pitch, pile height, pile thickness, and pile fineness. (Col. 2, lines 4-30).

Katoh, et al. states that the "sliding of a mat on a carpet can be prevented by implanting pile yarns made of a rigid material into the reverse side of the mat at a proper pitch to a proper density so that the piles (cut piles) may stick into the pile layer of the carpet laid beneath and are not easily bent by a sliding force. In some embodiments of Katoh, et al., the cut piles (b) have their tips swollen by heat-melting so as to have an increased anchoring effect. (Col. 1, line 60 – col. 2, line 33).

The Office Action acknowledged at page 5 that Katoh, et al. completely fails to teach certain limitations of former dependent claim 117 and independent claims 133 and 146, such as the basis weight range for the woven fabric included in the primary backing. Nevertheless, Katoh, et al. was combined with Kimmel, et al. in an attempt to render these claims obvious.

Kimmel, et al. is directed to tufted carpeting comprising a unitary primary backing having a woven synthetic scrim with a backing layer of staple fibers needled onto its back surface before tufting. Suitable yarn is tufted through the backing, the bases of the tufts being at least partially surrounded by the backing layer, and latex or other sizing material is applied to the bottom surface after tufting. (Col. 1, lines 56-63).

Applicants respectfully submit that there would have been no motivation for one of ordinary skill in the art to combine Katoh, et al. with Kimmel, et al. in the manner suggested in the Office Action and arrive at Applicants' claimed carpet or primary backing. Kimmel, et al. is specifically directed to a unitary backing having a woven ribbon scrim with a first scrim side and a second scrim side and a deposit layer of staple fibers needled through the scrim to form a bottom fiber layer on one of the scrim sides and a subface fiber layer on the other scrim side, the bottom fiber layer being thicker than the subface fiber layer. (Col. 4). Applicants respectfully submit that viewing these references as a whole, as required under Section 103, one having ordinary skill in the art would not have been motivated to combine the multi-layered mat or rug of Katoh, et al. (which is designed not to slip when placed on carpets such as automobile flooring

carpets) with the unitary backing of Kimmel, et al., wherein a primary focus is on the needling of staple fibers through a woven scrim.

Additionally, Applicants respectfully submit that any combination of Katoh, et al. and Kimmel, et al. fails to disclose or suggest a primary backing having a dimensional stability of about 3 pounds to about 20 pounds, wherein the dimensional stability is determined by grabbing and pulling the backing at a 45 degree angle in relation to the warp and fill yarns of the backing such that the backing incurs approximately a 5% elongation. With regard to the dimensional stability claim limitation, the Office Action stated, for example, that "it is reasonable to presume that the Katoh invention inherently possesses said dimensional stability." (Office Action, at 4). Applicants respectfully disagree.

To establish inherency, the evidence must make clear that the missing descriptive matter is *necessarily present* in the reference, and that it would be so recognized by persons of ordinary skill in the art. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Thus, an inherency rejection may not be based on what would result due to the optimization of conditions, but only on what was necessarily present in the prior art.

In the present case, a variety of factors may be altered to influence the dimensional stability of Applicants' claimed primary backing, including the types of components utilized, the weight ratio of the components, the needling process, and the like. For example, the amount of needling (e.g., the strokes per minute of the needles, the degree of penetration of the needles, and/or the advance rate of the components) may be adjusted to optimize the strength and adhesion characteristics of the primary backing. (Appl. at pages 11-12). Thus, to obtain Applicants' claimed dimensional stability limitation from the disclosure of Katoh, et al. and/or Kimmel, et al., one of ordinary skill would have to select from various possible conditions and parameters. For example, to achieve the dimensional stability required by the claims, one would have to select the appropriate weight ratios, type of components, needling amounts, and/or other appropriate values. Consequently, Applicants respectfully submit that the

claimed dimensional stability limitation does not necessarily flow from the teachings of Katoh, et al.—alone or in combination with Kimmel, et al.—nor is Applicants' claimed dimensional stability limitation necessarily present in either the mat or rug described by Katoh, et al. or the unitary backing described by Kimmel, et al. Accordingly, Applicants respectfully submit that independent claims 113, 133 and 146 patentably define over Katoh, et al. in view of Kimmel, et al.

Independent claim 113 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,140,071 to Gee, et al. in view of Katoh, et al. Additionally, independent claims 133 and 146 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gee, et al. in view of Katoh, et al. and further in view of Kimmel, et al.

Gee, et al. is directed to a process for preparing a tufted carpet which consists essentially of feeding simultaneously into a tufting machine a woven or bonded nonwoven sheet of continuous polypropylene filaments and a dyeable, bonded, nonwoven sheet of continuous synthetic organic filaments, said sheets being fed in surface contact with each other, and tufting a pile yarn through both sheets to develop a tufted face made of tufts extending above the dyeable, bonded nonwoven sheet. The pile yarn in Gee, et al. is selected so as to be dyeable in conjunction with the dyeable, bonded nonwoven sheet. (Col. 1, lines 57-68).

The Office Action recognized at pages 6-7 that Gee, et al. does not teach certain limitations of the independent claims, such as a woven fabric having warp and fill yarns being *needlepunched* to a bonded nonwoven fabric. However, the Office Action combined Gee, et al. with Katoh, et al. (and further with Kimmel, et al.), stating that "it would have been obvious to one skilled in the art to needlepunch the two sheets together prior to feeding into a tufting machine in order to produce a preformed dual layer primary backing that does not require modification of a tufting process line." The Office Action continued that "it would have been obvious to needlepunch the two layers together before tufting in order to ease handling and processing of the primary backing and to increase the dimensional stability of said primary backing and, hence, the tufted carpet." (Office Action, at 6-7). Applicants respectfully disagree.

Gee, et al. explicitly *teaches away from* needlepunching two layers together in the formation of its tufted carpet. Specifically, Gee, et al. states the following:

The process of the invention provides a method of making a tufted carpet from a primary backing of polypropylene having high tensile and tear strength **whereby diminution of such high strength by a separate needling step**, such as that used when dyeable staple fibers are needled to the upper surface of the backing, **is avoided** while at the same time the upper surface of the carpet backing is rendered dyeable.

(Col. 3, lines 36-43) (emphases added). Additionally, in the Background of the Invention section, Gee, et al. describes a previous patent that involved a needling operation (needling a layer of staple, unbonded fibers onto one surface of a scrim), stating that “the needling operation greatly reduces the tear strength of the tufted, pile carpet produced from the backing.” (Col. 1, lines 9-32).

In contrast, independent claims 113, 133, and 146 all require the primary backing to include a composite fibrous material that consists of a woven fabric having warp and fill yarns *needlepunched* to a bonded nonwoven fabric. Applicants respectfully submit that when viewing Gee, et al. as a whole, the reference explicitly *teaches away from* having any sort of “needling step” in a process for preparing a tufted carpet because of concerns over possible strength decreases. Accordingly, Applicants respectfully submit that Gee, et al. teaches away from Applicants’ carpet and/or primary backing of claims 113, 133, and 146, wherein the primary backing includes a woven fabric *needlepunched* to a bonded nonwoven fabric. And there would have been no motivation for one of ordinary skill in the art to combine Gee, et al. with Katoh, et al. and/or Kimmel, et al. and somehow arrive at Applicants’ claimed carpet and/or primary backing. Accordingly, Applicants respectfully submit that claims 113, 133, and 146 patentably define over the combination of Gee, et al. and Katoh, et al. and further in view of Kimmel, et al.

Various dependent claims were rejected in the Office Action using the above-discussed references, alone or in combination. Applicants respectfully submit, however, that at least for the reasons indicated above relating to independent claims 113, 133, and 146, the dependent claims patentably define over the cited references. Applicants also note that the patentability of such dependent claims does not necessarily hinge on

the patentability of independent claims 113, 133, and 146. In particular, some or all of the dependent claims may possess features that are independently patentable, regardless of the patentability of independent claims 113, 133, and 146.

In summary, Applicants respectfully submit that the present claims patentably define over all of the prior art of record for at least the reasons set forth above. As such, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Juska is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this Amendment.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

DORITY & MANNING, P.A.



Tara E. Agnew
Registration No. 50,589

DORITY & MANNING, P.A.
P. O. Box 1449
Greenville, SC 29602-1449
Phone: (864) 271-1592
Facsimile: (864) 233-7342

Date: Nov. 29, 2004